

REMARKS

Status of Claims

Claims 1-13 and 25-36 remain pending in the present application. Applicant has amended Claims 1, 25, 32, 33, 34, 35, 36. Support for these amendments may be found throughout the Specification. No new matter is being submitted.

Prior to this response, Applicant had filed an Appeal Brief and received the Examiner's Answer ("the Answer"). Applicant responds herein to the Examiner's Non-Final Office Action dated January 24, 2008. However, since the Examiner has maintained all of the rejections of the Non-Final Office Action in the Answer and since the Examiner has clarified many of her arguments in the Answer, Applicant references the Answer throughout these Remarks in order to respond to all points set forth by the Examiner and in an attempt to further prosecution.

35 USC § 103 – Rejection of Claims

The Examiner has rejected Claims 35-36 under 35 U.S.C. §103(a) as being unpatentable over Sano *et al.* (USPN 6,705,372). Applicant has amended Claims 35 and 36 rendering these grounds of rejection moot. Applicant also points out deficiencies in the rejections, where applicable, throughout this and the following rejections.

Claims 35-36

At page 4 of the Answer, the Examiner alleges that it would have been obvious to one of ordinary skill in the art "to make the base adjustable/movable" to "yield greater mobility to the clamping system and greater flexibility to the holding of a workpiece." However, Claims 35 and 36 do not merely recite adjustability or movability as alleged by the Examiner. Thus, in addition

to the amended language, the cited reference Sano fails to teach all of the elements of the claimed invention.

First, Applicant has amended the preamble of Claim 35 to require a *combination including fixture and a bat*, both of which are positively recited, wherein the fixture positions bats of various diameter at a preselected elevation. If the Examiner agrees that this amendment overcomes this issue, Applicant will amend the preambles of the dependent claims to agree with the preamble of the independent claim.

Claim 35 also now requires the base plate is slidable toward or away from a fixture base. This requires actual movement of the base plate rather than the “relative motion” of other elements, as the Examiner argues throughout the Answer.

Claim 35 also requires the base plate be slidable a distance dependent on a second distance moved by the camming surface and the pair of jaws. These elements are not taught or otherwise suggested by the cited art of record. The Sano alleged base plate (41a) is not slidable. And, for sake of argument, even if the alleged base plate of the Sano reference were to be made slidable, which Applicant denies, there is no teaching or suggestion anywhere in the reference which would provide that the Sano device would repeatedly position bats of varying diameter at a preselected elevation or that the jaws would move a preselected distance relative to the distance moved by the base plate. This is due to the fact that the relationship between movement of the jaws and movement of the alleged base plate is not taught or otherwise suggested.

Additionally, Applicant has amended Claim 35 to require that the camming surface extends from the jaw and that the base plate is slidable along the camming surface (extending

from the jaw). Referring to Figure 7 of Sano, the base plate 41a is not slidable and therefore does not slide along the camming surface extending from the jaw.

In the first paragraph of page 6 of the Answer, continuing from page 5, the Examiner admits that the alleged base plate (41a) is not movable by itself. This admission, in addition to the above amendments which overcome the Examiner's relative motion/movement arguments are believed to overcome the Examiner's rejection of Claim 35.

Additionally, in the following paragraph of page 6, the Examiner states that the movable base plate has a camming surface according to the Applicant's specification. Applicant believes the Examiner is confused because Claim 35 states, "a camming surface extending from each of said pair of slidable jaws..." – not the base plate. Moreover, the Examiner should be aware that applying the Applicant's teachings to the prior art in order to render an obviousness rejection is improper.

With regard to Claim 36, the Examiner again alleges, paraphrasing, that Sano is only missing the claimed adjustability. The Examiner has again misstated the claimed invention for ease in maintaining the cited rejection. Claim 36 previously required more than mere adjustability and still does.

Claim 36, as amended, requires a **movable** base plate. Thus the Examiner cannot rely on mere relative motion. In addition, Claim 36 now requires the "jaws to move a preselected distance dependent on a **distance moved by said movable base plate.**" This is more than just a mere adjustability or movability as alleged by the Examiner. This limitation requires movement of the jaws and the base plate and a relationship between the movement of each component.

Further, Applicant has amended this clause to further address the “relative movement” argument that Examiner explained in the Examiner’s Answer.

Similarly, still referring to Claim 36, the claim requires that the base plate camming surface extend from the opposed jaws and cause, “said jaws to move a preselected distance relative to a distance moved by the base plate.” This language specifically requires movement of the base plate by itself in order to move the jaws a preselected distance. It is believed that the Examiner misstated the clam language in rendering this rejection previously.

Additionally, Claim 36 states that the base plate camming surface extends from the opposed jaws. The Examiner continually recites that the camming surface is part of the base (41). See page 6, full paragraph above inserted Figure 7. However, Claim 36 requires that the camming surface extend from the opposed jaws. Applicant is confused by the Examiner’s continued arguing of a misstated limitation.

In the last paragraph of page 7, at line 3 of the Answer, the Examiner again alleges that it would have been obvious to make the base adjustable/movable by adding a sliding plate. There are two problems with the Examiner’s position. First, neither Claim 35 nor 36 recite only an adjustable or movable base plate. Claim 35 recites that the fixture apparatus repeatedly positions bats of various diameters at a preselected elevation and repeatedly positions a center point of each of the bats at a preselected longitudinal and latitudinal position. This is due to the fact that the camming surface extends from each of said pair of slidable jaws, said base plate [is] slidable toward or away from a fixture base along said camming surface, said base plate [is] slidable a distance dependent on a second distance moved by said camming surface and said pair of jaws. Similarly, with regard to Claim 36, the camming surface is required to extend from opposed jaws

and engage the base plate causing the jaws to move a preselected distance dependent on a distance moved by the base plate. This is more than the mere adjustability and movability alleged by the Examiner.

Second, the Examiner has completely disregarded the Applicant's previous arguments and is nonresponsive to the following issue. Sano teaches that the alleged base plate (41a, Figure 7) is firm and non-movable in order to join tubes together. A movable base would inhibit the proper joining of tubes which is the main function of Sano. Thus the Examiner's proposed modification would render the Sano device unsatisfactory for its intended purpose. Such is improper and the Examiner is respectfully referred to MPEP 2143.01(V).

In the first lines of page 8 of the Answer, the Examiner again alleges that the base does have relative motion, however, the Examiner admits that the Sano base is not movable by itself. Again, the Examiner is referred to amended Claims 35 and 36, described above, which as amended are believed to resolve the issue of relative motion and are not met by Sano.

Further, the Appellant again respectfully points out to the Examiner, that the Sano device does not repeatedly position bats, or tubing for that matter, of various diameters at a preselected elevation. This is because Sano fails to teach a movable base plate. This is also because Sano fails to teach a movable base plate which moves based on a distance moved by the jaws and vice versa, as currently claimed.

In the first full paragraph of page 8 of the Answer, the Examiner again alleges that the sliding of the alleged base plate (41a) would be obvious. However, the Examiner has disregarded the teaching of Sano which requires a non-movable surface (41a) in order to seat two tubes which are going to be joined together by the device. The Examiner's proposed movement

would render the Sano device inoperable since the tubes would not be able to be joined repeatedly and consistently.

Further, where the Examiner alleges that the adjustability or movability would be obvious, Applicant respectfully points out to the Examiner that **mere adjustability or movability** are not claimed. Claim 35 specifically requires that the fixture apparatus repeatedly position bats of various diameters at a preselected elevation and repeatedly position a center point of each of the bats at a preselected longitudinal and latitudinal position. This is due to the claimed relationship between the movement of the jaws and the movement of the base plate. Thus, despite use with differing bats of various diameters, the bats will be positioned in the same location, which is impossible with the Sano device, which has a non-movable plate for joining tubes.

Finally, still referring to the first full paragraph of page 8, the Examiner again admits that the base is not adjustable or movable. It is noted that the Examiner continually exchanges the terms “base” and “base plate” adding to the difficulty in understanding the Examiner’s argument. Applicant reminds the Examiner that the movable element cited throughout out the claims is a “base plate” (which differs from the claimed “base”) and Sano’s alleged “base plate” (41a): (1) is not movable and (2) does not move based on a distance movement by the jaws. Moreover, the base is not required to have relative motion, as alleged by the Examiner. The claimed **movable base plate is required to move** in both Claims 35 and 36. Finally, Claim 35, as amended, does not recite relative motion of the base plate. The claim, as amended, recites that the base plate be slidable toward or away from a fixture base along said camming surface, said base plate being slidable a distance dependent on a second distance moved by said camming surface and said pair

of jaws. This is not taught by Sano and further such modification would render Sano inoperable as previously indicated.

Moving to page 9, at line 3 of the Answer, the Examiner notes a “difference of perspective” and cites the difference in Figure 1 and Figure 7. Appellant asserts to the Examiner that regardless of which figure the Examiner is discussing, the element numbers of Figure 1 refer to the same elements having the same numbers in Figure 7. Further, and still referring to page 9, the Examiner asserts that the jaws (42) slide along the base (41a) and therefore the base does have relative motion. However, the term “relative to” is no longer utilized by the Appellant. The claim language of Claims 35 and 36 now requires a **movable base plate**, and that the **base plate** move a distance depending on the distance moved by the jaws. **The movement of the base plate is now explicit** and overcome the Examiner’s relative movement argument. Applicant asserts, and believes the Examiner would agree that the claimed term is movable and alleged “base plate” of Sano (at 41a) is not movable.

Further in the same paragraph of page 9, the Examiner, while admitting the lack of movability of the base plate, merely alleges that it would have been obvious to make the base (claim term: base plate) be adjustable or movable. However, the Examiner never addresses the Appellant’s previous assertion that such movability would render the Sano device unsatisfactory for its intended purpose. Applicant maintains that a movable base plate (41a) would render Sano in operable since such design would not provide a firm base for tubes being joined. The Sano reference teaches a firm surface (41a) in order to provide a seat for the tubes being joined.

At page 9, the Examiner has inserted text from the Sano patent which further damages her argument. The inserted text states, “A tube guide 40 for accurately setting the tubes is

fixed....” The Appellant has continuously argued that the base plate (41a) is fixed. This is so that the tubes can be accurately set and joined by the Sano device. Despite this teaching and despite the Examiner inserting language which further the Applicant’s argument while hindering her own argument, the Examiner continues to argue that the alleged base plate (41a) could be movable despite the fact that such modification would render the Sano device inoperable and despite the fact that Sano teaches away from such movement. The Examiner should be aware that such modification of the prior art is improper. MPEP 2143.01(V, VI)

At page 10, line 3 of the Answer, the Examiner alleges that the slidable base plate (as alleged by the Examiner) would yield a movable base plate, relatively. First, Appellant asserts that the claim language does not merely state that the base plate is movable. The distance of the jaw movement is claimed to be dependent on a distance moved by the base plate. Thus, Claim 36 requires specific, explicit movement of the base plate and not this “relative motion” that the Examiner applies to the non-movable Sano plate (41a). Further, Claim 35 requires that the base plate be movable dependent on a distance moved by camming surface and the pair of jaws. The claim language does not require relative motion, **but that the base plate indeed be slidable**. Applicant has made this clear not only through the teachings of the disclosure, but through the prosecution and attempted further clarification suitable to the Examiner by way of amendment of the pending claims.

Additionally, the Examiner cites that it would have been obvious to make the elements adjustable. Appellant asserts that there is no teaching in Sano for such movement nor is there teaching for the interrelation of movement of the jaws, a specific distance dependent on a

distance moved by the base plate, or vice versa for that matter. Thus, Applicant again asserts that mere adjustability or movability of a base plate is not claimed in the pertinent claims.

The Appellant maintains that the Examiner has relied on improper hindsight reasoning. For example, the Examiner repeatedly refers to the Applicant's teaching for motivation, violating the case law that she cites in the Answer at the top of page 11. For example, the Examiner states, "according to the appellant's specification the base plate has a camming surface." (subsection A, first paragraph). The Examiner also states "the movable base plate has a camming surface according to appellant's specification." (page 6, lines 7-9, first full paragraph). Additionally, although the Examiner states that the base plate may be made adjustable, there is no teaching in the prior art for such or the interrelationship of movement of the jaws and base plate as required throughout the pending claims. In sum, the Examiner continually violates her own cited case law which requires that the knowledge for specific claim elements not be gleaned "only from the Applicant's disclosure." For the above reasoning, including the amended claim language provided herewith, Applicant asserts that Claims 35-36 should be allowed and respectfully requests these grounds of rejection be withdrawn.

Claims 1-13 and 25-26

Claim 1

The Examiner has rejected Claims 1-13 and 25-26 over Sano in view of Comulada. Applicant has amended various independent claims rendering this ground of rejection moot. Applicant also maintains that the Examiner's cited art fails to teach every element of the claimed invention.

Applicant has amended the Preamble of Claim 1 to make clear to the Examiner that the claim is a combination claim and that the bat is a positively recited element, as has been previously explained to the Examiner throughout the prosecution. Upon overcoming the Examiner's issue regarding acceptance of the bat as a positively recited element, Applicant will gladly amend the preambles of the dependent claims to coincide with independent Claim 1.

The Examiner states, on page 11 of the Answer, that it would have been obvious to make the base (read: "base plate") adjustable/movable to yield greater mobility to the clamping system and greater flexibility for holding the workpiece. Sano fails to teach such movable base plate (41a). Further, the Examiner has again failed to acknowledge the inoperability of the Sano device by rendering the alleged base plate (41a) movable. The Examiner's proposed modification would render the device unsatisfactory for its intended purpose, as previously described.

Claim 1 also requires an **angled** camming surface for the base plate. Sano fails to teach any **angled** camming surface. As shown in Sano Figure 7, all alleged camming surfaces are horizontal and not angled (from the vertical or horizontal). Comulada also fails to aid this missing claim element.

Now referring to the Answer, the Examiner addresses the term "leveling" and recites various definitions from Webster's dictionary. The Examiner selects one of several definitions to meet her argument. However, the Examiner has chosen this definition in a vacuum and failed to consider the additional claim elements providing further support for Applicant's definition of the term "level" or "leveling". While Comulada may meet the Examiner's selected definition, Comulada, as well as Sano, alone or in combination, fail to meet the other limitations, which in

combination with the term “level” recite the claimed invention. In sum, the Examiner has taken the term “level” out of the context of the claim language.

The Appellant has repeatedly stated that the claimed invention levels various bats of various diameters by bringing the bats of various diameters to a preselected elevation regardless of the diameter of the bat. First, Sano and Comulada fail to teach a bat which is a positively recited element. Second, Sano fails to level bats, as taught, described and claimed by Applicant, because the alleged base plate (41a) is not movable. Beyond these arguments, the Examiner states that Comulada meets the claim term of leveling. It is noted that the Examiner defines level by using the term “level” throughout her argument on Page 12. This is circular.

As previously discussed with the Examiner and pointed out throughout the prosecution, Comulada levels a workpiece by making the workpiece horizontal or flat, to utilize the definition understood from Examiner. **The Comulada device would not level workpieces of different diameters by bringing the workpieces to a preselected position or elevation**, as claimed. Moreover, Sano also fails to provide such functionality as claimed since the alleged base plate (41a) is stationary and, therefore, if tubes of differing diameter are utilized, the elevation of the center point of the tubes and the outer surface of the tubes would differ with the differing diameters. Thus the Examiner’s proposed combination fails to meet the claimed invention.

On page 12 of the Answer, the Examiner again alleges that Comulada teaches a leveling device that meets the Applicant’s claim limitation. The Examiner recites language from column 2 and column 3 of Comulada and alleges that the Comulada reference teaches that a top surface must be held level for uniform ablation. However, Comulada teaches ablation of similarly sized parts. These parts must be maintained in a flat orientation (level as the Examiner defines, not the

Applicant). As taught and claimed in the Applicant's pending claim set, bats of various diameter may be utilized by leveling or bringing the bats to the proper elevation and distance from the engraving device. Such leveling at a preselected elevation is not possible with the Sano device, which utilizes a **stationary** or **fixed** base plate (41a). Moreover, even if the Sano base plate (41a) were movable, Sano as well as the Examiner's other references, fail to teach a movement of such base plate which is related to a distance moved by the jaws (42).

Finally, the Examiner has utilized a definition of the term "level" which differs from that taught by the Appellant. The Examiner is respectfully reminded that an Applicant may be a lexicographer. "An applicant is entitled to be his or her own lexicographer" MPEP 2111.01(IV); See also *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings"). When the Applicant teaches a specific definition, the Examiner may not pick and chose from alternative definitions in order to maintain a rejection. Applicant has repeatedly stated throughout this prosecution that the term level is taught as bringing the bats of various diameters to the same elevation. Level, on the other hand, as alleged by the Examiner, does not mean to make something flat with respect to a horizontal with respect to this application. The Examiner is referred to [0024] page 4, lines 18-20; [0033] page 8, lines 11-12; [0035] page 8, line 29 – page 9, line 2; paragraph [0035] describes the function of the device and therefore implicitly provides further definition of the term "leveling".

The Examiner next alleges that the Applicant has attacked references individually. Applicant has repeatedly addressed both Sano and Comulada, as well as various other references

during the course of this prosecution. Applicant has focused on Sano, because certain elements that the Examiner alleges to be found in Sano, are certainly not. There is no reason to address a second reference, if a first reference fails to teach all that is alleged by the Examiner since the rejection fails. However, Applicant does not understand how the Examiner can make such allegation that only Sano has been attacked. Applicant invites the Examiner to either explain this allegation or invites the Examiner to call the Applicant's counsel to discuss in order clarify Applicants understanding of this argument.

Claim 25

With regard to Claim 25, and referring to page 13 of the Answer, the Examiner has alleged previously that the jaws (42) of Sano include camming surfaces which extend from the jaw surfaces. The amended claim language requires that the base plate camming surface be "inwardly extending". The alleged camming surfaces are not inwardly extending as required by Claim 25.

Moreover, the Examiner's cited language in the rejection of Claim 25, at page 13, fails to teach or suggest any inwardly extending base plate camming surface. The language only states that the springs urge the claws inwardly. Applicant has amended this phrase to state that the camming surface is inwardly extending. Sano fails to teach any **inwardly extending** camming surface, but instead teaches outwardly extending surfaces from the outer surfaces of the jaws 42.

Applicant has also amended the claim language to recite that the camming surface causes movement of the base plate dependent upon the distance moved by the jaws. Sano and Comulada fail to teach such limitation and relationship of parts and movement as previously described.

In the middle of page 13 of the Answer, the Examiner alleges that a tube is the functional equivalent of a bat and asserts that intended use is not germane to patentability. The Examiner has repeatedly disregarded the Applicant's assertion that the term "bat" is positively recited throughout the various independent claims. Applicant has taken the further step of amending the preamble of Claim 25 to recite a combination claim including the bat. As a positively recited element, the bat is a claim element, and therefore must be considered as a structural element of the claim. Applicant requests the Examiner to explain how a noun (a bat) can be intended use language.

Finally, still referring to the middle paragraph at page 13, the final sentence of the paragraph citing *Ex parte Masham* appears to be an incomplete thought and is not understood by the Applicant. Nonetheless, Applicant reviewed the cited case description at MPEP 2114 and can easily distinguish. Applicant's claims continuously recite "a bat" and "said bat" throughout the body of the claim. To the contrary, the *Masham* application recites "flowing material" in the preamble and only states "the flowing material" in the body of the claim described. Thus, as explained to the Examiner several times previously, the claim element "a bat" is positively recited as a claim limitation throughout the claim set.

The Examiner is also respectfully referred to MPEP 2114 to the heading: "A Prior Art Device Can Perform All The Functions Of The Apparatus Claim And Still Not Anticipate The Claim"

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed

the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.).

The Examiner alleges all functionality to be taught by the cited combination, which is incorrect. But even if she were correct, the movable base plate (structure) is not taught and the inter-relationship of base plate movement to jaw movement is not taught, among other elements. Therefore the rejection fails.

Claim 32

Next, the Examiner turns to Claim 32 at page 13 of the Answer. Applicant maintains that the at least one base plate move a distance dependent on a distance moved by the at least one jaw and further requires an **angled camming surface** operably engaging the base plate and at least one jaw is not taught or suggested by Sano. Specifically, the Sano reference fails to teach the angled camming surface which operably engages both the base plate and the at least one jaw as recited by Claim 32. The Examiner alleges that jaws 42 include angled sides, but the claim language **requires angled camming surface**. The angled sides or edges on the rear surface of jaws 42 are not camming surfaces as they do not cause movement of any other parts. These angled sides are merely braces, **not angled camming surfaces as claimed**. In other words, no camming occurs along the angled edges cited by the Examiner. Applicant asserts that the Examiner has misrepresented the claim language in maintaining a claim rejection. Specifically, the angled camming surface is not shown. Further, the alleged camming surface operably engaging the base plate (41a) and the at least one jaw is not shown.

Claim 32 also requires the **jaws and the base plate to engage the bat**. Applicant respectfully refers the Examiner to Sano, Figure 17B. The figure shows that the alleged base

plate fails to engage the tubes. Were the tubes engaged by the base plate, as required by the claims, the Examiner would see that the tubes of Figure 17A would be at a different height than 17B, rather than equal elevations as also required by the claims. For purpose of Examiner's understanding, the tubes in Figure 17B are removed from the base plate because the tubes are rotated by rotor (30).

Again the Examiner alleges that it would be obvious to make the base adjustable/movable. Claim 32 does not recite a merely adjustable or movable base plate. The base plate is claimed to move a distance dependent upon the distance moved by the jaws. This limitation is missing from the Sano reference as well as the Comulada reference, in addition to the movable base plate.

Claim 32 also requires an **angled** camming surface operably engaging both the base plate and the at least one jaw. This allows the retaining of bats of varying diameter at equal elevations regardless of the bat diameter with a fixed base plate (41a). However, the Sano and Comulada references alone or in combination both fail to teach such limitations. As previously discussed, use of tubes of different size would position the upper elevations of the tubes at different elevations because the alleged Sano base plate (41a) is fixed. Thus, the Examiner's assertions are incorrect and the cited references fail to teach all of the limitations of the claimed invention.

The Examiner next returns to the issue of the **positively recited bat** element. A bat is positively recited at line 6 of Claim 32. The body of the claims specifically states, "a bat...." Accordingly, the bat is not merely a functional or intended use limitation, as alleged by the Examiner. The bat is instead a positively recited element of the claim. If the Examiner would like to discuss further amendment to the preamble, as with Claims 35 and 36, Applicant's

counsel would be willing to discuss such amendment. Nonetheless, the bat is a noun which is a positively recited element of the claim.

In the second full paragraph of page 15 of the Answer, the Examiner alleges that Sano teaches that bats of varying diameter can be positioned at equal elevations, regardless of the bat diameter. The Examiner next inexplicably refers to Figure 7, Figure 11 and Figures 17A & 17B.

First, it is respectfully pointed out to the Examiner that the tubes of Figures 17A and 17B are the same tubes, not tubes having different diameters. As discussed in the Sano specification, these tubes are rotated by a rotor device (30) between the position of Figures 17A and 17B. Thus, the Figures 17A, 17B do not show “differing tubular diameter,” but instead show the same pair of tubes rotated from a first position to a second position, rendering the Examiner’s statement incorrect. Second, even if the pair of tubes 17A, 17B were of differing diameter, since the base plate (41a, Figure 7) is not movable, the upper most elevation of the larger diameter tubes would be higher than the smaller diameter tubes. Therefore, the Sano reference fails to teach the claimed limitation which has been repeatedly argued and explained to the Examiner during this prosecution.

Referring to the line of text at the bottom of page 16 of the Answer, while Sano could accommodate tubes of varying diameters, the Figures 17A, 17B do not show such. Moreover, the elements shown in Figure 7 clearly indicate that the bottom of the base plate (41a) is fixed and, therefore, tubes of different size would not be at equal elevations when placed between the jaws (42). The Examiner is also referred to line 7 of Claim 33 which requires the bat be engaged by the at least one base plate and the at least one jaw.

Referring to the inserted text at page 17 of the Answer, and the subsequent paragraph, and still related to Claim 32, the Examiner has apparently failed to grasp the claimed invention. If the bat diameter changes from a first bat to a second bat, then the elevation of the bat will vary when referring to the combination of Sano and Comulada. Sano fails to teach a movable base plate which moves relative to or dependent upon a distance moved by the jaws. Comulada only teaches a leveling with respect to a horizontal, not elevationally with workpieces of different sizes. It does not aid with the failure of Sano. Specifically, Comulada does not teach a base plate which is movable to accommodate bats, or tubes, of varying diameter to maintain a consistent distance from the laser ablation device.

Claim 33

Referring now to the rejection of Claim 33, near the bottom of at page 17 of the Answer, the Examiner alleges that the Appellant does not have basis for a vertical plane. First, it is worth noting that the Examiner is making a claim for lack of support after nearly five years of prosecution. In any event, the vertical movement of the base plate is clearly taught throughout the specification and claims. Such vertical movement defines a plane. Moreover, the movable base plate lends, in part, to the ability to position different diameter bats at equal elevations which is claimed throughout the pending claim set. Since the specification teaches that the base plate moves vertically, the vertical plane would be defined, for example, by any two points of the base plate between a first position and second position, respectively, of the base plate.

Next, in the last two lines of page 17 of the Answer, the Examiner alleges that the Sano base plate is movable relative to the motion of the jaws (42). Again, the Examiner has relied upon the “relative motion” argument. The amended claim language requires a base plate slidable

through a vertical plane a distance dependent upon a distance moved by said at least one jaw.

The claim therefore now require the base plate is **slideable** and the sliding is a **distance dependent** upon a distance moved by the at least one jaw. Applicant asserts that this overcomes the Examiner's "relative motion" argument. Sano and Comulada, alone or in combination, fail to teach a base plate which moves a distance based upon a distance moved by the at least one jaw. Additionally, Applicant has removed reference to "relative motion" in the above phrase of Claim 33.

Further, as previously stated, the Sano and Comulada references fail to teach an **angled** camming surface, as required by the claim.

Additionally, Applicant notes that Sano and Comulada also fail to teach a base plate which moves relative to **all of** the three claimed elements – the base, the at least one jaw and the angled camming surface. At the top of page 18 of the Answer, the Examiner cites language from Sano indicating that the jaws 42 move. However, the alleged base plate (41a) does not move with respect to all three of the base, the at least one jaw and the angled camming surface. Additionally, the Sano base plate (41a) fails to move vertically dependent upon the distance moved by the jaws 42, as previously indicated. This limitation is claimed throughout Applicant's claims, including Claim 33 and is not taught or suggested by Sano or Comulada, alone or in combination. Applicant notes respectfully that the Examiner has continually made generalizations which have allowed her to maintain various rejections. Applicant notes there are multiple failures of the cited combination to teach each and every element of the claimed invention, which is required for a proper §103 Rejection.

Claim 34

Referring now to page 18, Claim 34 rejection of the Answer, again the Examiner refers to the positively recited bat element and alleges that this is an intended use limitation. However, as previously indicated to the Examiner on multiple occasions, the term “bat” is a positively recited element of the claim and is not an intended use limitation. For some inexplicable reason, the Examiner has continuously disregarded this assertion by the Applicant. Applicant respectfully asks the Examiner how a noun (a “bat”) can be considered intended use (“verb”) language? As previously indicated, Applicant would be willing to discuss the amendment of the preamble if such amendment would overcome the Examiner’s issue of considering the bat as a positively cited element of the claim.

Moreover, Applicant has amended Claim 34 to specifically require a movable base plate. The Examiner has repeatedly alleged that Sano teaches a base plate (41a). However, the alleged base plate (41a) is not movable, as required by Claim 34. Further, as previously described, Sano fails to teach the inter-relationships of movement or claimed components and, therefore, fails to teach all of the elements of the claimed invention. Specifically, Sano in combination with Comulada, fails to teach that, “said first and second jaw slidably receive said bat and cause said movable base plate to modify the vertical position of said bat to maintain an equal distance of said bat to said marking device regardless of said bat diameter.”

Referring now to page 19, the Examiner alleges that the Appellant has only attacked a single reference in the combination rejections of Comulada. Where one cited reference fails to teach one or more elements, as alleged by the Examiner, the combination rejection fails as a whole. Applicant has continually addressed the elements of the claims which the Examiner

alleges to be taught by Sano, but which Sano fails to teach. Applicant has also maintained that Comulada fails to teach these missing elements and therefore that the rejections fail for the various reasons provided.

Applicant has amended Claim 34 to require explicitly that the base plate be **movable**. Sano fails to teach a movable base plate which has a movement which is related to distance moved by the jaws (42). Referring to Sano Figure 17a, which is cited by the Examiner, the alleged base plate (41) (including the base plate 41a of Figure 7) is a stationary, nonmovable surface. When tubes of differing diameter are positioned against this stationary surface, the outer surface of the tubes will differ in position due to the differing diameter. Again, **Sano fails to teach a movable base plate**. Similarly, Comulada also fails to teach a movable base plate. Moreover, in making this rejection, the Examiner has provided no teaching on the part of Comulada which meets the previous limitations recited. Applicant has attacked both references, contrary to the assertions of the Examiner, throughout this prosecution.

Referring now to the bottom paragraph of page 19 of the Answer, the Examiner again alleges that the base plate is movable relative to the motion of the jaws (42). First, the language of Claim 34 does not recite that a “the base plate is movable relative to the motion of the jaws”. The claim requires that the first jaw and second jaw slidably receive a bat and cause the movable base plate to modify the vertical position of the bat to maintain “an equal distance of the bat to the marking device regardless of the bat diameter”. This only occurs because the base plate is movable some distance related to the distance moved by the jaws. This structural interrelationship accommodates and allows for maintaining a consistent distance of the marking device away from the surface of a bat regardless of the bat diameter. Thus, the Appellant again

asserts that the correct claim language has not been addressed by the Examiner, and the Examiner has improperly maintained this rejection. Claim 34 is not met by the combination of Comulada and Sano.

Finally, at the bottom of page 19 and continuing onto page 20 of the Answer, the Examiner again alleges that it would have been obvious to make the sliding plate adjustable or movable. However, the Applicant again asserts to the Examiner that such movable base plate (41a) would render the Sano device inoperable because the tubes (7, 8) would not be consistently joinable if not positioned on a firm, nonmoving surface. Therefore, the Examiner's assertion of obviousness is incorrect, in addition to the above cited reasoning, since the prior art would be rendered inoperable.

Claim 35

Referring now to Claim 35, and the rejection at page 20 of the Examiner's Answer, the Examiner admits that the only teaching of the camming surface and base plate is derived from the Applicant's disclosure. The Examiner should be aware that Application of the Applicant's teaching to the prior art is improper for rendering a §103 rejection.

More importantly, the Examiner's assertion above is incorrect. The camming surface and the base plate are not necessarily the same. The Examiner is referred to Figure 4 of the Applicant's disclosure which shows the camming surface 60 is not "one and the same" as the base plate.

As Applicant understands the Examiner's comment regarding Claim 35 at page 20 of the Answer, the Examiner has used portion of the Applicant's disclosure in combination with Sano in making this rejection. This is wholly improper.

Additionally, Applicant incorporates the arguments provided previously in this response for Claim 35 and respectfully invites the Examiner to refer to those arguments, rather than repeat them again.

Claim 36

Referring now to the rejection of Claim 36, at page 20 of the Examiner's Answer, the recited claim language requires that the base plate be slidable relative to the base and the opposed jaws. The Examiner has admitted throughout her Answer that the alleged base plate (41a) does not move. The alleged base plate (41a) is not slidable as required by the claim language. Moreover, the alleged base plate (41a) is not **movable**, as amended and currently claimed. relative to the base and also is not slidable relative to the opposed jaws, since the base plate (41a) cannot move. Claim 36 further requires that the base plate camming surface extends from the opposed jaws and engages the base plate causing the jaws to move a preselected distance dependent on a distance moved by the base plate. In other words, depending on the distance moved by the base plate, the jaws will move a preselected distance corresponding to the base plate movement. Such structural interrelationship between these elements is not taught or suggested by Sano, and further is not taught or suggested by Comulada. Additionally, at the top of page 21, the Examiner states that Sano teaches a base plate surface (41a) extending from opposed jaws. The claim language fails to require any base plate surface extending from the opposed jaws. Instead, the correctly recited claim language requires that the base plate **camming** surface extend from the opposed jaws. Once again, the Examiner has misstated the claim language and accordingly, her rejection is improper.

Finally, at page 21 of the Examiner's Answer, the Examiner addresses the movable clamp (12) and the inoperability of the Sano device. The Examiner has again misstated the Appellant's assertions. The clamp (12) (Figure 8) is required for proper use of the Sano device. This clamp is also indicated generally by element (120) in Figure 1. Correct use of the Sano device requires that the clamp (12, 120) be closed over the tubes (7, 8) being joined. Appellant asserts that the closure of the clamp (12, 120) would inhibit marking of the bat as claimed variously throughout the pending claims. One the other hand, removal of this clamp, as previously alleged by the Examiner, would render the Sano device inoperable. The Examiner should be aware that such modification is improper MPEP 2141.03(V, VI)

Claims 2-13 & 26-31

Applicant has previously addressed each pertinent independent claim, of the rejected dependent claims, and believes the independent claims overcome the art of record and further believes these claims to be in condition for allowance. Applicant therefore respectfully requests this ground of rejection withdrawn.

Claim 1-13 and 25-26

Referring now to page 22, Section C of the Examiner's Answer, the Examiner alleges at the end of the first full paragraph that "Baum shows that laser cutting/engraving of baseball bats is known." The Appellant has repeatedly asserted to the Examiner that this interpretation of the Baum reference is improper.

Baum clearly teaches that a laser is utilized to cut a wood veneer which is placed on the bat *after the laser processing*. Therefore, Baum fails to teach the laser cutting engraving of a baseball bat as alleged by the Examiner. **Instead, a sheet of wood is processed with a laser**

and subsequently applied to a baseball bat. The Appellant has even provided to the Examiner the prior art with the underlined text shown in column 4 in lines 45-65. Apparently, the Examiner has either chosen to not review this documentation or has chosen to disregard this explicit teaching of the Baum reference. In either event, Appellant asserts to the Examiner that her allegation is improper.

The next paragraph of page 22, the Examiner notes that Baum is used to teach that it is known to use laser cutting/engraving/ablation on baseball bats. Again, the Examiner is incorrect. The laser is used to cut a wood veneer sheet which is subsequently positioned on a baseball bat. However, the laser cutting does not occur to the baseball bat directly. The claimed invention is entirely different from that which is taught by Baum.

Following in the last paragraph of page 22, the Examiner again addresses the movable clamp of Sano. Applicant maintains that the movable clamp (12, 120) would inhibit laser engraving of a tube or bat. However, the clamp (12, 120) is required for retaining the tubes in position. So, (1) either the clamp (12,120) would need to be removed for the Examiner's proposed modification, which would render the Sano device inoperable for its intended use, or (2) the Sano device could not be used for engraving, as alleged in the Examiner's proposed modification. In either event, the Examiner's rejection fails.

Regarding the remaining claim elements, the Examiner is referred to, and the arguments are incorporated herein, the previously recited comments regarding Claim 36.

For these reasons, Applicant again respectfully requests that the Examiner remove these grounds of rejection and expedite this case to issuance.

CONCLUSION

Applicant's attorney believes that the instant application is currently in condition for allowance and therefore respectfully requests that the Examiner allow the pending claims. However, if the Examiner believes there are other unresolved issues in this case, Applicant's attorney would appreciate the courtesy of a telephone call at (502) 584-1135 to resolve such remaining issues.

Respectfully submitted,

MIDDLETON REUTLINGER

/James E. Cole/

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